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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,185	08/23/2001	Charles W. Propst Jr	TPP 30482 A	9479

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Thomas P Pavelko
Stevens Davis Miller & Mosher
Suite 850
1615 L Street NW
Washington, DC 20036

EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/914,185	Applicant(s) PROPST JR, CHARLES W.	
	Examiner Christopher P Bruenjes	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7,10-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

WITHDRAWN REJECTIONS

1. The 35 U.S.C. 102 rejection of claims 1-2 and 4 as anticipated by Berbeco of record in the Office Action mailed October 27, 2003, Page 4 Paragraph 8, has been withdrawn due to Applicant's arguments in the Paper filed January 27, 2004.
2. The 35 U.S.C. 102 rejection of claims 5-8 as anticipated by Shaw of record in the Office Action mailed October 27, 2003, Pages 4-5 Paragraph 9, has been withdrawn due to Applicant's arguments in the Paper filed January 27, 2004.
3. The 35 U.S.C. 102 rejection of claims 5 and 10-12 as anticipated by Keough of record in the Office Action mailed October 27, 2003, Pages 5-6 Paragraph 10, has been withdrawn due to Applicant's amendments in the Paper filed January 27, 2004.
4. The 35 U.S.C. 103 rejection of claims 5-7 over Arudi in view of Felter of record in Paper #4, Pages 6-7 Paragraph 6, has been withdrawn due to Applicant's amendments in the Paper filed January 27, 2004.

5. The 35 U.S.C. 103 rejection of claims 10-13 over Hamuro et al in view of Felter of record in Paper #4, Pages 8-9 Paragraph 8, has been withdrawn due to Applicant's amendments in the Paper filed January 27, 2004.

6. The 35 U.S.C. 103 rejection of claim 3 over Berbeco in view of Felter of record in the Office Action mailed October 27, 2003, Pages 7-8 Paragraph 11, has been withdrawn due to Applicant's arguments in the Paper filed January 27, 2004.

7. The 35 U.S.C. 103 rejection of claims 7 and 13 over Keough in view of Felter of record in the Office Action mailed October 27, 2003, Pages 8-9 Paragraph 12, has been withdrawn due to Applicant's arguments in the Paper filed January 27, 2004.

NEW REJECTIONS

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the

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invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, 5-7, 10, 12-13, 15-16, and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Sugimoto et al (USPN 5,981,048).

Sugimoto et al anticipate a self-sustaining film (reference number 1a, Figure 1). The inner thermoplastic resin film is a self-sustaining film because the inner and outer films are separately prepared films that are self-sustaining before being laminated together via an extrusion laminated adhesive layer (col.6, 1.66-67). The inner thermoplastic resin film includes an acrylic resin such as ethylene-methyl methacrylate (col.19, 1.62-67 and col.20, 1.1-15), which is a methylmethacrylate containing polymer. The composition further contains an antistatic agent in an amount of about 0.001 to 5wt% of the self-sustaining film (col.9, 1.66-67 and col.10, 1.1-12). The antistatic agent includes quaternary ammonium chloride, sulfate, salt, or nitrate (col.24, 1.44-45 and col.25, 1.13-25). The composition also contains a lubricant (col.9, 1.66-67 and col.10, 1.1-12). The lubricant includes polyethylene wax (col.10, 1.43-46 and 1.62-63). Finally, the composition

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includes a light-shielding material (col.10, 1.38-42). The light-shielding material includes zinc oxide (col.11, 1.8-14).

Regarding claims 5-7, the film (reference number 1a, Figure 1) is described in the third embodiment (Figure 3) as being coated onto a Kraft paper layer (reference number 6, Figure 3 and col.7, 1.54-67). Note coated is defined as "covered with a layer", in which the film (1a) is a layer covering the paper layer. Furthermore, the limitation "coated with" is not closed language and does not require that the coating is in direct contact with the paper.

Regarding claims 10 and 12-13, the third embodiment teaches a package comprising the composition claimed and a paper layer (col.7 1.54-67).

Regarding claims 15-16 and 18-20, the fourth embodiment teaches a package comprising the composition claimed (reference number 1a, Figure 4) covering or coating both sides of the intermediate layer comprising at least two laminae (both laminae are represented by reference number 4a, Figure 4). Both laminae are plastic (col.8, 1.41-44).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berbeco (USPN 4,596,668) in view of Sugimoto et al (USPN 5,981,048).

Berbeco teaches a self-sustaining film that can be extruded into antistatic mats, rods, or cables (col.4, 1.1-8). The film comprises a composition including an acrylic resin base, which is a methylmethacrylate containing polymer (col.2, 1.55-65). The composition further comprises 0.1 to 20wt% based on the

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weight of the self-sustaining film of antistatic agent (col.2, 1.20-30) to impart a static dissipative property and a conductive property to the film. The antistatic agent is a quaternary ammonium compound (col.3, 1.3-20).

Berbeco fail to explicitly teach a polyethylene wax emulsion in the composition forming the self-sustaining film. However, Sugimoto et al teach that lubricants such as polyethylene wax are added to anti-static films in order to improve film moldability (col.10, 1.1-12). One of ordinary skill in the art would have recognized that a lubricant would be added to a composition that is extruded or molded into antistatic mats, rods, or cables, in order to improve the film moldability of that composition, as taught by Sugimoto et al.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to add a lubricant such as polyethylene wax to the antistatic composition of Berbeco, in order to improve the film moldability of that composition, as taught by Sugimoto et al.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berbeco and Sugimoto et al as applied to claim 1 and in further view of Felter et al (USPN 4,895,886).

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Berbeco and Sugimoto et al taken as a whole teach all that is claimed in claim 1 as shown above, but fail to suggest why the self-sustaining film further comprises a dispersion of zinc oxide particles. However, Felter et al teach a static dissipative composition including acrylic resin base and quaternary ammonium compounds of choline and another quaternary ammonium long chain antistat, in which a dispersion of silica or zinc oxide particles are added in order to stabilize the composition by preventing phase separation of antistatic agents (col.2, 1.63-65). One of ordinary skill in the art would have recognized that both Berbeco, Sugimoto et al and Felter et al are teaching conductive and static dissipative or anti-static compositions and that zinc oxide particles are added to conductive and static dissipative compositions in order to stabilize the composition by preventing phase separation of the antistatic agents, as taught by Felter et al.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to add a dispersion of zinc oxide particles to the conductive and static dissipative composition of Berbeco and Sugimoto et al combined, in order to stabilize the conductive and static dissipative composition, as taught by Felter et al.

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11. Claims 5, 10-12, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keough (USPN 4,623,594) in view of Sugimoto et al (USPN 5,981,048).

Keough teaches a package for electronic devices (col.4, 1.65-68) composed of paper, fabric, non-woven material, or metallized substrates coated with an antistatic coating (col.3, 1.42-58). The antistatic coating consists of an acrylic resin base (col.2, 1.49-68) and an antistatic agent, including quaternary ammonium compounds (col.3, 1.28-40). Keough also teaches that the exact amount of quaternary ammonium compound added to the polymer will vary from resin to resin, antistatic agent to antistatic agent, and intended use for the resulting product (col.3, 1.40-47). However, Keough also teaches specific examples in which the quaternary ammonium compound is added in an amount of 5, 10, or 15 wt% based on the weight of the composition (col.5, 1.5-55). Keough further teaches that the coating is applied by extrusion (col.4, 1.16-19) to at least one side but can be applied to both sides of the substrate (col.3, 1.64-68).

Keough fails to explicitly teach a polyethylene wax emulsion in the composition forming the self-sustaining film. However, Sugimoto et al teach that lubricants such as polyethylene wax are added to anti-static films in order to

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improve film moldability (col.10, 1.1-12). One of ordinary skill in the art would have recognized that a lubricant would be added to a composition that is extruded or molded, in order to improve the film moldability of that composition, as taught by Sugimoto et al.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to add a lubricant such as polyethylene wax to the antistatic composition of Keough, in order to improve the film moldability of that composition, as taught by Sugimoto et al.

12. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keough and Sugimoto et al as applied to claims 5 and 15 and in further view of Felter et al (USPN 4,895,886).

Keough and Sugimoto et al taken as a whole teach all that is claimed in claims 5 and 18 as shown above, but fail to suggest why the self-sustaining film further comprises a dispersion of zinc oxide particles. However, Felter et al teach a static dissipative composition including acrylic resin base and quaternary ammonium compounds of choline and another quaternary ammonium long chain antistat, in which a dispersion of silica or zinc oxide particles are added in order to

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stabilize the composition by preventing phase separation of antistatic agents (col.2, 1.63-65). One of ordinary skill in the art would have recognized that both Keough, Sugimoto et al and Felter et al are teaching conductive and static dissipative or anti-static compositions and that zinc oxide particles are added to conductive and static dissipative compositions in order to stabilize the composition by preventing phase separation of the antistatic agents, as taught by Felter et al.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to add a dispersion of zinc oxide particles to the conductive and static dissipative composition of Keough and Sugimoto et al combined, in order to stabilize the conductive and static dissipative composition, as taught by Felter et al.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Akao et al (USPN 5,637,364); Atake (US 2002/0142181).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 571-272-1489.

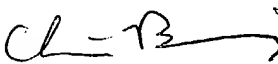
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The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB 
March 12, 2004


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

3/29/04